

Appl. No. 09/345,815  
Amendment dated May 6, 2004  
Reply to Office Action of February 6, 2004

## REMARKS

### Pending Claims

Claims 4, 5, 10-13, 15, and 16 are pending in the Application.

### Non-Statutory Double Patenting

The Examiner has rejected claims 4, 5, 10-13, 15, and 16 under the doctrine of obviousness-double patenting, over claims in copending Application 09/838,821. Applicants respectfully traverse this rejection as improper, and respectfully request withdrawal of this rejection.

As noted in the Final Office Action, the **only** ground of rejection remaining in the present application is a **provisional** nonstatutory double patenting rejection. (See page 2 of the Office Action) Applicant respectfully points the Examiner's attention to MPEP Section 804 I B, discussing provisional double patenting rejections. In particular, Applicant's note the following:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application **unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.**

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Because the **provisional** double patenting rejection is the only rejection remaining in this application, Applicant asserts the Examiner should withdraw the rejection and permit this application to issue as a patent. The **provisional** double patenting rejection in the copending application may then be converted to a **double patenting** rejection at the time the instant application issues as a patent.

### CONCLUSION

In view of the foregoing, the Applicants believe that all claims as currently pending are in condition for allowance. A notice of allowance is requested.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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Date:

6 May 2004

**23552**

PATENT TRADEMARK OFFICE

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## RESTRICTION IN APPLICATION FILED UNDER 35 U.S.C. 111: DOUBLE PATENTING

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**I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED**

A double patenting issue may arise between two or more pending applications, between one or more pending applications and a patent, or between one or more pending applications and a published application. A double patenting issue may likewise arise in a reexamination proceeding between the patent claims being reexamined and the claims of one or more applications and/or patents. Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

**A. Between Issued Patent and One or More Applications**

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.

**B. Between Copending Applications—Provisional Rejections**

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each

application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

**C. Between One or More Applications and a Published Application - Provisional Rejections**

Double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a "provisional" rejection on the ground of double patenting. See the discussion regarding "provisional" double patenting rejection in subsection B. above.

**D. Reexamination Proceedings**

A double patenting issue may raise a substantial new question of patentability of a claim of a patent, and thus be addressed in a reexamination proceeding. *In re Lonardo*, 119 F.3d 960, 966, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) (In giving the Commissioner authority under 35 U.S.C. 303(a) in determining the presence of a substantial new question of patentability, "Congress intended that the phrases 'patents and publications' and 'other patents or publications' in section 303(a) not be limited to *prior art* patents or printed publications." (emphasis added)). Accordingly, if the issue of double patenting was not